Claim amendments

Claim 1 has been amended to more clearly recite the claimed invention. Claims 31 and 32, which relate to a recombinant MVA virus containing and capable of expressing an HIV nef gene inserted into the MVA genome, and Claims 33 and 34, which relate to a recombinant MVA virus containing and capable of expressing a human tyrosinase gene inserted into the MVA genome have been added. Support for Claims 31-34 can be found in Claims 1, 6 and 7 of the specification. Thus, Claims 31-34 fall within the invention of Group I.

Remarks

The claims in the referenced application relate to a recombinant MVA virus (Groups I, III, IV, VII and VIII) and methods of using the recombinant MVA virus (Groups II, V and VI). The Examiner has restricted the subject matter into 8 groups. In particular, the Examiner states that:

- the compositions of Groups I and IV "are related as product and process of use" but that the "recombinant virus can be used for in vitro expression of viral or non-viral proteins" (Office Action, pages 2-3);

the compositions of Groups I and III "are related in that the cells of invention III are infected with the virus of Invention I, however, these cells are a differing composition, being used for different purposes, and the methods have different steps to different ends" (Office Action, page 3);

the compositions of Groups I and VII "are separate and distinct as they are two differing compositions" (Office Action, page 3); and

the compositions of Groups I and VIII "are separate and distinct, as the viruses of invention III have differing properties set forth in the claims of invention I" (Office Action, page 3).

Applicants respectfully disagree. Group IV claims relate to "cells infected with MVA virus and non-native nucleic acid" (Office Action, page 2), therefore, the compositions of Groups I and IV cannot be distinct based upon a product and process of use rationale. Furthermore, restriction among the compositions of Groups I, III, IV, VII and VIII should not be required. As noted in the Manual of Patent Examining Procedure (MPEP):

> Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition (MPEP 806.04).

The claims of Groups I, III, IV, VII and VIII are drawn to compositions which comprise the same essential characteristic, *i.e.*, recombinant MVA virus of Group I. Similarly, restriction among the methods of Groups II, V and VI should not be required since the inventiveness of the method claims are based on the same essential characteristic of the recombinant MVA virus of Group I.

Finally, as also indicated in the MPEP,

> If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions (MPEP 803, page 800-3, column 2).

A search of the claimed compositions and methods in the application can be made without serious burden. This is indicated by the fact that, as discussed above, the inventive aspect of the compositions and methods is the recombinant MVA virus, and the fact that the subject matter of the claims overlap. For example, the composition of Claim 28 is present in Group II and Group VIII.

Conclusion

Restriction in the subject application should not be required. At a minimum, Applicants respectfully request reconsideration of the restriction requirement such that the subject application be restricted to two groups, one group for the claimed compositions and the other group for the claimed methods.

Respectfully submitted,

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